



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/698,423 | 11/03/2003 | Clark Easter | 026063-00018 | 1510 |

4372 7590 09/21/2004

ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

SMITH, TRACI L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,423

Applicant(s)

EASTER ET AL.

Examiner

Traci L Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-19 fail to meet the requirements of the technological arts as not having a method and system that is implemented using a computer. The steps are simple abstract ideas that do not use or involve the

Art Unit: 3629

technological arts. The steps could simply be performed thru human interaction via a conversation or written reports.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-31 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The method system and program claimed in the invention has been on sale and/or in use since February 4, 2001 in www.4glsoftware.com; any linkage; *March 03, 2001; retrieved from the wayback machine on August 25, 2004 hereinafter referred to as 4GL. The invention is described in detail at www.4glsoftware.com. As shown on Page 17 of the entered art three of the four named inventors work for the company that sells the software package.

4. As to claims 1, 19 and 31 4GL teaches a method, system and program of receiving dates (Pg. I. 6).

5. Identifying service plans within the date range (pg. 5 I. 11)

6. Identifying encounters within the plan(Pg. 5 I. 7).

7. As to claim 2 4GL teaches a method with individual education plans(IEP)(Pg. 5 I. 11).

Art Unit: 3629

8. As to claims 3 and 10 4GL teaches a method comparing expected service with identified encounters. (Pg. 5 l. 21-23).
9. As to claim 4 4GL teaches a method of producing a number of shortfall or surplus encounters. (Pg. 14 l. 5-6)
10. As to claim 5 4GL teaches a method of comparing expected numbers with identified numbers. (Pg. 14 l. 6-7)
11. As to claims 6, 9 and 11 4GL teaches a method of a result of shortfall or surplus of services. (Pg. 14 l. 10-13)
12. As to claim 7 4GL teaches a method of dividing a date range into a time period. (Pg. 14 l. 29)
13. As to claim 8 4GL teaches a method of comparing expected and identified numbers from one time period to another. (Pg. 15 l. 13-15)
14. As to claim 12 teaches a method of tracking an encounter that is reported late.(pg. 5 l. 13)
15. As to claim 13 4GL teaches a method of providing dates encounters took place. (Pg. 5 l. 19-20)
16. As to claims 14-16 4GL teaches a method for entering and storing information regarding encounter types and encounters associated with an individual service plan and provider. (Pg. 8 l. 12-16 & p. 9 l.6-8).
17. As to claim 17 4GL teaches a method with encounters of missed services (Pg.5 l. 14-15).
18. As to claim 18 4GL a method of storing the information resulting from an encounter. (Pg. 7 l. 21-23).

Art Unit: 3629

19. As to claim 20 4GL teaches a system for compliance management with a processor, user interface and database. (Pg. 18 l. 1-5).

20. electronic forms identical to paper forms so that personnel know how to fill them out on a computer that gets saved on the database. (Pg. 9 l.5-3 & 13)

21. IEP forms pull from banks of goals and objectives and compliance checking using the forms the user fills out to determine other information about encounters (Pg. 9. 1-2 & 6-8)

22. As to claim 21 4GL teaches system with a terminal NT platform (Pg. 15 l. 33-34)

23. As to claims 22 and 24 4GL teaches a system with a PC. (Pg. 18 l.9-10)

24. As to claim 23 4GL teaches a system with a processor housed in a server (pg. 18 l. 6)

25. As to claims 25 and 30 4GL teaches a system with a server coupled to a network (Pg. 19 l. 1)

26. As to claim 26 4GL teaches a system with a network as the internet. (Pg. 19 l. 18-19)

27. As to claim 27 and 28 4GL teaches a system with a server and a networking system. As to this being "coupled", coupling is inherent in any networked computer system.(Pg. 19 l. 1 and 17-20)

28. As to claim 29 4GL teaches a system with a server to store the database. (Pg. 19 l. 12)

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent6,270,351 B1 Roper; August 7, 2001; Individual

Art Unit: 3629

Education Tracking Program System. A system with automated means for creating and administering an entire individual education plan. European Patent EP 1 237 096 A2, Ishizka et al.; September 9, 2002; A system and method for managing documents that allows the user to manage documents via interactive display menus. Non-Patent Literature, PR News wire, New York; February 29, 2000. *'Microsoft Names Winners of Technology Achievements in Education Awards.'*

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

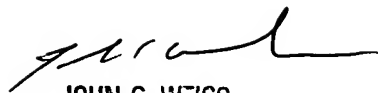
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/698,423

Page 7

Art Unit: 3629

Tls



JOHN G. WEISS
SUPERVISORY PROJECT EXAMINER
TECHNOLOGY CENTER 3600